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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/631,161	07/31/2003	Armin Fehn	WAS 0596 PUS / Wa 10223-	7543
22045	7590	06/07/2005	EXAMINER PENG, KUO LIANG	
BROOKS KUSHMAN P.C. 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075			ART UNIT 1712	

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/631,161	<b>Applicant(s)</b> FEHN ET AL.	
	<b>Examiner</b> Kuo-Liang Peng	<b>Art Unit</b> 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 3/18/05 Amendment.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 17-22 and 24-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17, 21-22, 28 and 31 is/are rejected.
- 7) ☒ Claim(s) 18-20, 24-27, 29 and 30 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The Applicants' preliminary amendment filed on March 18, 2005 was received. Claims 1-16 and 23 are deleted. Now, Claims 17-22 and 24-31 are pending.
2. Claim rejection(s) under 35 USC 112 in the previous Office Action (Paper No. 1204) is/are removed.
3. Claim rejection(s) under 35 USC 102 in the previous Office Action (Paper No. 1204) is/are removed.
4. The indicated allowability of Claims 17 and 31 are withdrawn in view of the newly discovered reference(s) to Ebbrecht (US 5 552 506). Rejections based on the newly cited reference(s) follow.

#### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject

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matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 17, 21-22, 28 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyoshi (EP 1 043 363) in view of Ebbrecht.

For Claim 17, Miyoshi discloses a silicone rubber mold obtained by curing an addition curable composition in the presence of a rhodium catalyst. ([0002], [0010]-[0015], [0017]-0023)) Miyoshi is silent on the use of the specific rhodium catalyst set forth in the instant claim. However, Ebbrecht discloses the use of rhodium catalysts in a hydrosilylation reaction. The catalysts include  $\text{RhX}_3(\text{SR}^2_3)_3$ ,  $\text{RhR}^4_3$ ,  $\text{Rh}(\text{CO})_2\text{R}^4$ , etc. wherein  $\text{R}^4$  is 2,4-pentanedionato group; X is a halogen group, preferably a chlorine group. (col. 5, lines 51-62) Note that there appears to have a typographical error in  $\text{RhX}_3(\text{SR}^2_3)_3$ . It should read  $\text{RhX}_3(\text{SR}^3_2)_3$ . The motivation of the using these rhodium catalysts is to obtain exclusively a desired 1,2-addition reaction product. (col. 6, lines 6-9) In light of the benefit mentioned, it would have been obvious to one of ordinary skilled in the art at the time of the invention was made to utilize Ebbrecht's rhodium catalysts in Miyoshi's addition reaction. Note that "baking" in the preamble of the instant claim is merely an intended use, and does not carry any weight of patentability. See MPEP 2111.02.

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Applicants allege, "This phrase ["baking mold"] is not an intended use, but is a true claim limitation and describe a product, not a condition." (Remarks, page 6, last paragraph) However, it is not persuasive because a baking mold is still just a mold, and reference only needs to be capable of "baking". The "baking" part is merely a future intended use for the mold itself. Further, "baking" describes heat applied in a furnace, and does not require a food product application. For Claims 21-22, 28 and 31, Miyoshi discloses a silicone rubber mold obtained by curing an addition curable composition in the presence of a rhodium catalyst. ([0002], [0010]-[0015], [0017]-0023]) Since Miyoshi's curable composition is substantially the same as Applicants' composition, Examiner has a reasonable basis to believe that both have the same appearances including transparency, color, etc. *In re Best*, 195 USPQ 430 (CCPA 1977).

7. Claims 18-20, 24-27 and 29-30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Miyoshi does not teach or fairly suggest the specific mold set forth in the instant claims.


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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp  
June 2, 2005

  
Kuo-Liang Peng  
Primary Examiner  
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